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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,499	12/18/2003	Andrew M. Bober	JD-427	1498

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT PAPER NUMBER

1772

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/707,499	BOBER ET AL.	
	Examiner	Art Unit	
	Alicia Chevalier	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-12 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

Due to the confusion in the last office action mailed April 4, 2006, i.e. the incorrect response being addressed and the contradictory statements of finality, it is here by *vacated* and a new action follows. See interview summary mailed September 1, 2006.

1. Claims 1, 3-12 and 14-21 are pending in the application, claims 20 and 21 are withdrawn from consideration. Claims 2 and 13 have been cancelled.
2. Amendments to the claims, filed on January 23, 2006, have been entered in the above-identified application.

WITHDRAWN REJECTIONS

3. The 35 U.S.C. §102 and §103 rejections made of record in the office action mailed September 23, 2005, have been withdrawn due to Applicant's amendment in the response filed January 23, 2006.

NEW REJECTIONS

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 102

5. Claims 12, 14, 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross (U.S. Patent No. 5,830,529).

Regarding Applicant's claim 12, Ross discloses a surface modifying laminate comprising a perforated carrier film (*col. 55, lines 8-10 and figure 33*) and an indicia-containing layer (*col. 55, lines 1-3*). The perforated carrier film has an upper surface and a lower surface and is deemed capable of at least partially covering a surface to be modified (*col. 54, line 65 through col. 55, line 1 and abstract*). The carrier film is also transparent and, as such, it is capable such to have the indicia containing layer visible through the carrier film (*col. 55, lines 8-10*). The indicia-containing layer is disposed on at least a portion of the lower surface of the carrier layer (*col. 55, lines 1-3 and figure 33*).

Regarding Applicant's claim 14, Ross discloses that the indicia-containing layer is substantially continuous layer covering substantially the entire carrier film (*figure 33*).

Regarding Applicant's claim 15, the limitation "wherein the indicia-containing layer is printed onto the lower surface of the carrier film" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Ross discloses an indicia layer on the lower surface of the carrier film.

Art Unit: 1772

Regarding Applicant's claim 18, Ross discloses that the carrier film comprises a film selected from the group consisting of polypropylene films, polyacetal films, polyamide films, polyanhydride films, polyester films, polyolefin films, polystyrene films, polyvinylchloride films, polyvinylidene chloride films, polyurethane films, and polyurea films (*col. 58, lines 1-4*).

Claim Rejections - 35 USC § 103

6. Claims 1, 3-11, 16, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross (U.S. Patent No. 5,830,529) in view of Orensteen et al. (U.S. Patent No. 5,508,105).

Regarding Applicant's claims 1 and 19, Ross is relied upon as described above. Ross further discloses a transparent top layer (*col. 54, lines 60-61*).

Ross fails to disclose a cured top coat.

Orensteen discloses a signage article comprising a cured top coat (*multi-function coat, col. 8, line 35*) which is also crosslinked to improve weatherability (*col. 9, lines 12-21*).

Ross and Orensteen are analogous because they both disclose display/signage articles.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Orensteen's top coat as the top coat in Ross in order to improve the weatherability of Ross's article.

Regarding Applicant's claim 3, Ross discloses that the indicia-containing layer is substantially continuous layer covering substantially the entire carrier film (*figure 33*).

Regarding Applicant's claim 4, the limitation "wherein the indicia-containing layer is printed onto the lower surface of the carrier film" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of

Art Unit: 1772

forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Ross discloses an indicia layer on the lower surface of the carrier film.

Regarding Applicant's claim 5, Ross discloses that the carrier film is perforated (*col. 55, lines 8-10 and figure 33*).

Regarding Applicant's claim 6, Ross discloses that the carrier film comprises a film selected from the group consisting of polypropylene films, polyacetal films, polyamide films, polyanhydride films, polyester films, polyolefin films, polystyrene films, polyvinylchloride films, polyvinylidene chloride films, polyurethane films, and polyurea films (*col. 58, lines 1-4*).

Regarding Applicant's claim 7, Orensteen discloses that the top coat is not alkali-soluble top coat (*col. 9, lines 12-21*).

Regarding Applicant's claim 8, Orensteen discloses that the top coat is a crosslinked top coat (*col. 9, lines 12-21*).

Regarding Applicant's claim 9, Ross discloses that the top coat is a permanent top coat (*col. 54, lines 60-61*).

Regarding Applicant's claim 10, Orensteen discloses that the top coat is selected from the group consisting of acrylic coatings, polyurethane coatings, vinyl coatings and epoxy coatings (*col. 10, lines 13-49*).

Regarding Applicant's claim 11, Ross discloses a boding layer disposed between the surface to be modified and the indicia-containing layer (*col. 54, line 65 and figure 33*).

Art Unit: 1772

Regarding Applicant's claims 16 and 17, neither Ross nor Orensteen discloses that the carrier film comprises an average of at least 1 perforation per square foot or no more than about 200 perforations per square foot (*paragraph 32*).

However, the exact perforations per square foot of the carrier film is deemed to be a result effective variable. It would require routine experimentation to determine the optimum value of a result effective variable, such as perforations per square foot, in the absence of a showing of criticality in the claimed perforations per square foot. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

ANSWERS TO APPLICANT'S ARGUMENTS

7. Applicant's arguments in the response filed January 23, 2006 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1772


CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac
10/06/06


ALICIA CHEVALIER
PRIMARY EXAMINER